



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.	CONFIRMATION NO.
09/520,476	03/08/2000	Aslam A. Malik	04906-013843	2209

7590

03/19/2002

Townsend and Townsend and Crew L.L.P.
Two Embarcadero Center
8th Floor
San Francisco, CA 94111-3834

EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 03/19/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,476

Applicant(s)

MALIK ET AL.

Examiner

D. R. Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1713

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 12/26/01, has been fully considered with the following results.
2. Applicant has not provided a new oath and declaration as is required and the requirement is maintained.
3. The amendment does not overcome the obviousness-double patenting rejection which is also maintained.
4. The other objections and rejections are overcome by the amendment and are withdrawn.

Previously Cited Statutes

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Oath/Declaration

6. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. A supplemental oath or declaration is required under 37 CFR 1.67 for the reasons set forth in Detailed Action § 2 of the previous Office Action.

Obviousness Double Patenting

7. **Claims 20-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,703,194.** The basis of this rejection was stated in Detailed Action § 12 of the previous Office Action. The Examiner acknowledges that applicant has indicated a willingness to file a terminal disclaimer to overcome the rejection. However, as a terminal disclaimer has not been submitted the rejection is maintained.

Claim Rejections - 35 USC § 102(e)

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 1713

9. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. **Claims 20-26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hargis.**

The Examiner brought Hargis to the attention of applicant in the last Office Action, but did not make a rejection as it could not be determined whether the teachings which would be relied on existed in the C-I-P parent of Hargis. The Examiner has since determined that they do exist in the parent application, which makes the teachings of Hargis available as prior art. It is also noted that applicant has made no comment on Hargis..

11. Hargis discloses polyurethane elastomers comprising monomeric repeat units such as are instantly claimed (see the claims). Specific examples of the FOX monomers are shown in the examples and Hargis specifically teaches that these oxetane monomer may also be copolymers with tetrahydrofuran (col. 12, lines 18-21). The polyisocyanates taught to be used also include those such as are used in the instant invention (col. 4, lines 52-65). The use of cross-linking agents such as are used and claimed in the instant invention are taught (col. 5, line 31 to col. 6, line 12), and the use of liquid hydroxyl intermediates such as are known in the art are taught to be used as chain extenders (col. 3, lines 55-65).

12. **Claim 27 is rejected under 35 U.S.C. 102(e) as anticipated by Hargis or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hargis in view of Examiner's Notice.**

13. Hargis discussed above is deficient in not specifically indicating that 1,4-butanediol could be used as a chain extender. However, as indicated above the use of liquid hydroxyl intermediates such as are known in the art are taught to be used as chain extenders. The Examiner takes Notice that the use of 1,4-butanediol is known as a chain extender in the art of polyurethane elastomers and that 1,4-butanediol meets the limitations for such polyols set forth by Hargis at col. 3, lines 55-65. It would have been

Art Unit: 1713

obvious to one of ordinary skill in the art to use 1,4-butanediol as a chain extender in the urethane elastomers taught by Hargis for its known and intended purpose.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to be 'DR Wilson', with a long horizontal flourish extending to the right.

D. R. Wilson
Primary Examiner
Art Unit 1713